

REMARKS

This Amendment is being filed in response to second Final Office Action mailed on May 19, 2004. Applicant thanks the Examiner for the telephone interview conducted on March 24, 2004. During the telephone interview, Applicant's attorney and Examiner discussed Walker et al. (U.S. Patent 5,897,620) ("Walker") and article "Hawaiian Air to Offer Tickets Through ATMs" from the Wall Street Journal (hereinafter referred to as "Hawaiian Air"). It was agreed that amendments to the independent claims would be made to overcome the rejections under 35 U.S.C. 103 and 101 and that the arguments with regard to Walker's teaching away from the Hawaiian Air reference would be more clearly addressed. In response to the telephone interview, the pending second Final Office Action was issued to replace a first Final Office Action mailed on January 22, 2004.

Claims 1-16 and 34-75 are pending in the application. Claims 1, 34, 44, and 66 are being amended. Claims 65-74 stand objected to due to a misnumbering of these claims as there were two claims 65 when new claims 65-74 were filed in the Amendment filed December 23, 2003. Accordingly, these previously presented claims 65-74 are being renumbered to 66-75.

Claims 1-16 and 34-75 stand rejected. Claims 1-16, 34-43, 50-54 and 57-75 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-11, 14-16, 34-38, 41 and 44-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of the Hawaiian Air. No new matter is being introduced. Applicant respectfully requests reconsideration of the Application in view of the amendments and remarks herein.

Remarks Regarding Claim Rejections under 35 U.S.C. § 101

Claims 1-17, 34-43, 50-54 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the rejection argues that the claims do not apply, involve, use or advance the technological arts, because they are drawn to an abstract idea. However, the rejection acknowledges that the claims produce a useful, concrete, and tangible result (page 3, 3rd full paragraph of the pending Office Action).

Applicant has amended independent claims 1, 34, and 66 to recite, “customer uses the identifier to book one of the predetermined flights via a communications network”. Applicant respectfully submits that the amendment to the claim is such that the claim is now within the technical arts. Applicant, therefore, respectfully requests withdrawal of the rejection to claims 1-16, 34-43, 50-54 under 35 U.S.C. § 101.

Remarks Regarding Claim Rejections under 35 U.S.C. § 103

Claims 1-11, 14-16, 34-38, 41 and 44-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Hawaiian Air.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

As recited in amended claim 1, Applicant’s pre-paid airline ticket includes “an identifier ... operable to be utilized by the customer to book a flight on one of a plurality of predetermined flights, and ... a plurality of geographic flight parameters ... at least one of the plurality of geographic flight parameters being unspecified ... wherein a customer uses the identifier to book one of the predetermined flights via a communications network. ” Independent claims 34, 44, and 66 have been similarly amended.

Walker discloses a system by which airlines can fill seats that would otherwise remain empty (col. 3, lines 24-27). As disclosed in Walker at col. 2, line 30-col. 3, line 23, a traveler specifies geographic flight parameters (*i.e.*, a departure location and a destination location) and a time range for travel. Based on the parameters specified by the traveler, an *airline* assigns the traveler to a flight. Thereafter, Walker’s system issues a ticket with geographic flight parameters and flight times *specified* thereon.

Hawaiian Air discloses a system by which a given airline sells an open ticket to a customer for a future flight on that airline. The customer later uses the open ticket to book a Hawaiian Air flight.

Incorporating the Hawaiian Air open ticket into the system of Walker renders the system of Walker unworkable as a ticketing mechanism for an airline because the airlines of Walker must know the geographic and time parameters to assign a flight for the traveler. More specifically, the combination of the Walker system and the open ticket of Hawaiian Air is unworkable as the open ticket does not include an origination location or destination location and therefore would not allow the Walker system, which requires both the origination and destination locations, to book the flight. As stated in the previous amendment, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, if the open ticket of Hawaiian Air were used with the Walker system, a passenger would not be allowed to book a flight as Walker requires that the *airline* book the flight for the customer (i.e., the selection of the specific flights is performed by the airline and *not* the customer). Additionally, the Walker system requires that the *airline* book the flight, which is completely *opposite* to Applicant's amended claim 1 ("the identifier ... used by the customer to book a flight"). Again, the combination of Walker and Hawaiian Air produces an unworkable system.

Moreover, in the alternative, there is no motivation to combine the assigned ticket of Walker with the open ticket of Hawaiian Air since that would render the open ticket inoperable. Once the airline ticket of Walker is assigned by an airline, the functionality of the open ticket of Hawaiian Air is defeated. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

Accordingly, Applicant respectfully submits that the rejection of claims 1-11, 14-16, 34-38, 41 and 44-75 under 35 U.S.C. § 103(a) is improper for lack of a suggestion or motivation to combine Walker and Hawaiian Air. Therefore, Applicant requests withdrawal of the rejections under 35 U.S.C. § 103(a).

In addition to the combination of Walker and Hawaiian Air being improper as described above, claims 1, 34, 44, and 66 have been amended to recite "a customer uses the identifier to book one of the predetermine flights". Walker and Hawaiian, either alone or in combination, do not teach or suggest a customer booking a flight on "one of the predetermined flights" on which the pre-paid airline ticket may be used. Because Walker and Hawaiian, either alone or in combination, do not teach or suggest the recited limitation, Applicant respectfully requests that the rejections under 35 U.S.C. 103 be withdrawn.

CONCLUSION

In light of the above, Applicant submits that the Application is in condition for allowance, and such a Notice is respectfully requested. If there are any outstanding issues, the Examiner is requested to telephone Applicant's counsel to resolve such issues.

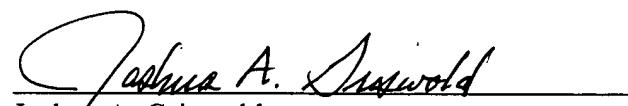
No fees are believed to be due. Please apply any other charges or credits to deposit account 06-1050.

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Respectfully submitted,

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